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04/22/2009

ALSTON & BIRD LLP  
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101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

EXAMINER

ROSEN, NICHOLAS D

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 04/22/2009

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,528	03/18/2005	Hee-Jung Ahn	038779/290107	8327

TITLE OF INVENTION: METHOD FOR CIRCULATING AN ELECTRONIC GIFT CERTIFICATE IN ONLINE AND OFFLINE SYSTEM

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1510	\$300	\$0	\$1810	07/22/2009

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE** OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

## HOW TO REPLY TO THIS NOTICE:

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If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

# **PART B - FEE(S) TRANSMITTAL**

**Complete and send this form, together with applicable fee(s), to:** **Mail** **Mail Stop ISSUE FEE**  
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**INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

826 7590 04/22/2009

**ALSTON & BIRD LLP**  
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I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,528	03/18/2005	Hee-Jung Ahn	038779/290107	8327

**TITLE OF INVENTION: METHOD FOR CIRCULATING AN ELECTRONIC GIFT CERTIFICATE IN ONLINE AND OFFLINE SYSTEM**

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1510	\$300	\$0	\$1810	07/22/2009

EXAMINER	ART UNIT	CLASS-SUBCLASS
ROSEN, NICHOLAS D	3625	705-026000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.  
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a **Customer Number is required.**

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 \_\_\_\_\_  
(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 \_\_\_\_\_  
3 \_\_\_\_\_

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

**PLEASE NOTE:** Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

- ☐ Issue Fee  
☐ Publication Fee (No small entity discount permitted)  
☐ Advance Order - # of Copies \_\_\_\_\_

4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)

- ☐ A check is enclosed.  
☐ Payment by credit card. Form PTO-2038 is attached.  
☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number \_\_\_\_\_ (enclose an extra copy of this form).

5. **Change in Entity Status** (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

**NOTE:** The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature \_\_\_\_\_ Date \_\_\_\_\_  
Typed or printed name \_\_\_\_\_ Registration No. \_\_\_\_\_

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ROSEN, NICHOLAS D

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 04/22/2009

## Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 455 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 455 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

**Notice of Allowability****Application No.**

10/528,528

**Applicant(s)**

AHN, HEE-JUNG

**Examiner**

Nicholas D. Rosen

**Art Unit**

3625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment of March 10, 2009.
2. ☒ The allowed claim(s) is/are 1-27.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date \_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_.

/Nicholas D. Rosen/  
Primary Examiner, Art Unit 3625

### **DETAILED ACTION**

Claims 1-27 have been examined.

#### ***Allowable Subject Matter***

Claims 1-4 and 24 are allowed.

The following is an examiner's statement of reasons for allowance: The closest prior art of record, Messner (U.S. Patent 6,370,514), discloses a gift certificate service system for managing sales, gifting, and usage of electronic gift certificates according to a request by a user's communication terminal through a network, comprising: a gift certificate service server for managing purchase, gifting, and usage operations on the electronic gift certificates from the communication terminal (Abstract; column 3, lines 4-20); and a gift certificate database, accessed by the gift certificate service server, for storing electronic gift certificate information, and processing a reply to an inquiry of electronic gift certificate usage from the gift certificate service server (ibid.; column 1, lines 19-33). Messner does not expressly disclose a distinct network server, accessed by the gift certificate server and accessing the user's communication terminal, but does disclose a voucher server which users' communication terminal access, and which accesses other servers, including merchants' gift certificate servers (Figure 3; column 5, lines 31-40; column 7, lines 18-43). Messner does not expressly disclose this voucher server/network server performing a client interface function with the purchase, gifting, and usage of the electronic gift certificates, and transmitting the user's gift certificate purchase particulars and gift certificate information for usage of the corresponding gift

certificate to the communication terminal, but does disclose a personal computer or other communication terminal of the user (column 5, lines 31-40; column 7, lines 17-27; Figure 3), and it is well known to transmit information on purchase particulars to users' personal computers or other communication terminals to perform client interface functions, as taught, for example, by Melero et al. (U.S. Patent Application Publication 2002/0111879) (paragraphs 54 and 59).

Messner does not expressly disclose storing electronic gift certificate information prior to transferring the gift certificate to a transferee, but Neofytides et al. (U.S. Patent Application Publication 2002/0152176) teaches storing gift certificates or other stored value instruments prior to transferring them to transferees (paragraph 22).

Messner does not expressly disclose that the electronic gift certificate is a multimedia message including barcode data, but Sliwa ("Retailers Mull Pulling Plug on E-Commerce") teaches emailing bar-coded gift certificates (paragraph beginning, "The Reynoldsburg, Ohio-based women's apparel retailer"), implying messages that include barcode data, and multimedia messages are well known as taught, for example, by Aho et al. (U.S. Patent Application Publication 2001/0039589) (paragraph 6). Messner does not expressly disclose that the electronic gift certificate information stored by the gift certificate database includes at least one of a gifting history of the gift certificates or a usage history of the gift certificates, but Benston ("Retailers Report Problems Verifying Gift Certificate Cards") teaches maintaining gift certificate histories on a computer, which from context appears to include at least one of a gifting history or a usage history (paragraph beginning, "An advantage of the cards, other than", et subseq.). However,

neither Messner, Sliwa, nor any other prior art of record discloses that the network server is responsive to use of the electronic gift certificate occasioned by displaying the barcode data on the communications terminal. Kitaura et al. (U.S. Patent Application Publication 2002/0091569) discloses an electronic coupon system wherein coupon barcodes can be displayed using cellular phones (see, e.g., paragraphs 115-118), but this is not the same as the recited claim limitation.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claims 5-9 and 27 are allowed.

The following is an examiner's statement of reasons for allowance: The closest prior art of record, Messner (U.S. Patent 6,370,514), discloses an electronic gift certificate circulating method, comprising: (a) receiving a user's purchase request from the communication terminal (column 7, line 45, through column 8, line 58); (c) settling the electronic gift certificate, and issuing the electronic gift certificate to the user, when the user requests settlement (column 8, line 59, through column 9, line 17); and (d) storing issued gift certificate information in a gift certificate database (column 9, line 66, through column 10, line 37). Messner does not expressly disclose (e) notifying the user of the gift certificate purchase particulars and gift certificate information for usage in a message format (although Messner does disclose notifying the user of the delivery or

non-delivery of the gift certificate to a recipient, as well as notifying a recipient of a gift certificate [column 9, lines 51-65]), but it is well known to notify users of purchase particulars, as taught, for example, by Melero et al. (U.S. Patent Application Publication 2002/0111879) (paragraphs 54 and 59).

Messner does not expressly disclose (b) checking a settlement state of the electronic gift certificate bought by the user, but Lindquist (U.S. Patent Application Publication 2003/0018553) teaches checking a settlement state of an electronic gift certificate bought by a user (paragraph 46).

Messner does not expressly disclose storing issued gift certificate information in the gift certificate database prior to transferring the gift certificate to a transferee, but Neofytides et al. (U.S. Patent Application Publication 2002/0152176) teaches storing gift certificates or other stored value instruments in a database prior to transferring them to transferees (paragraph 22).

Messner does not expressly disclose that the electronic gift certificate information stored by the gift certificate database includes at least one of gifting history of the gift certificates and usage history of the gift certificates, but Benston ("Retailers Report Problems Verifying Gift Certificate Cards") teaches maintaining gift certificate histories on a computer, which from context appears to include at least one of gifting history and usage history (paragraph beginning, "An advantage of the cards, other than", et subseq.).

However, Messner does not disclose that the communication terminal displays barcode data upon use of the electronic gift certificate, and neither does any other prior



art of record. In particular, Sliwa ("Retailers Mull Pulling Plug on E-Commerce"), discloses emailing bar-coded gift certificates to customers, and Kitaura et al. (U.S. Patent Application Publication 2002/0091569) discloses an electronic coupon system wherein coupon barcodes can be displayed using cellular phones (see, e.g., paragraphs 115-118), but this is not the same as the recited claim limitation.

Furthermore, because claim 5 is a method claim, it has been examined for qualifying as statutory under 35 U.S.C. 101, in light of *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). Because claim 5 is tied to a particular machine, the communication terminal, and could not be performed as purely mental steps, it is held to be statutory.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claims 10-14 are allowed.

The following is an examiner's statement of reasons for allowance: The closest prior art of record, Messner (U.S. Patent 6,370,514), discloses an electronic gift certificate circulating method, comprising: (a) receiving a user's gifting request from a communication terminal (column 7, line 45, through column 8, line 58); receiving

information on the gift certificate to be gifted and a transferee when the user's gift certificate, or a gift certificate purchasable by the user, is found (column 7, line 51, through column 8, line 68); and (d) transmitting the gift certificate selected by the user to the transferee (column 8, lines 36-58; column 9, lines 51-65); and Messner implies (e) updating the user's gift certificate information (e.g., by informing the user of the delivery or non-delivery of the gift certificate, column 9, lines 51-65) and storing updated information in a gift certificate database together with the transferee's gift certificate information (column 10, lines 21-57). Messner does not expressly disclose (b) inquiring an existence state of the gift certificate possessed by the user of the gift certificate database, and determining the existence state, but Cheong (U.S. Patent 7,006,993) discloses inquiring and determining the existence state of a gift certificate possessed by the user of the gift certificate database (column 11, lines 54-67).

Messner does not expressly disclose (f) notifying the user of the gift certificate gifting information in a message format (although Messner does disclose notifying the user of the delivery or non-delivery of the gift certificate to a recipient, column 9, lines 51-65), but it is well known to notify users of relevant information on purchases, as taught, for example, by Melero et al. (U.S. Patent Application Publication 2002/0111879) (paragraphs 54 and 59).

Messner does not expressly determining the existence state of the gift certificate prior to transferring the gift certificate to a transferee, but Neofytides et al. (U.S. Patent Application Publication 2002/0152176) teaches storing gift certificates or other stored value instruments in a database prior to transferring them to transferees (paragraph 22),

which implies determining their existence, since non-existent certificates cannot properly be transferred.

Messner does not expressly disclose that the electronic gift certificate is a multimedia message including barcode data, but Sliwa ("Retailers Mull Pulling Plug on E-Commerce") teaches emailing bar-coded gift certificates (paragraph beginning, "The Reynoldsburg, Ohio-based women's apparel retailer"), implying messages that include barcode data, and multimedia messages are well known, as taught, for example, by Aho et al. (U.S. Patent Application Publication 2001/0039589) (paragraph 6).

Messner does not expressly disclose that the electronic gift certificate information includes at least one of a gifting history of the gift certificates and a usage history of the gift certificates, but Benston ("Retailers Report Problems Verifying Gift Certificate Cards") teaches maintaining gift certificate histories on a computer, which from context appears to include at least one of gifting history and usage history (paragraph beginning, "An advantage of the cards, other than", et subseq.).

However, Messner does not disclose that the communication terminal displays barcode data upon use of the electronic gift certificate, and neither does any other prior art of record. In particular, Sliwa discloses emailing bar-coded gift certificates to customers, and Kitaura et al. (U.S. Patent Application Publication 2002/0091569) discloses an electronic coupon system wherein coupon barcodes can be displayed using cellular phones (see, e.g., paragraphs 115-118), but this is not the same as the recited claim limitation.

Furthermore, because claim 10 is a method claim, it has been examined for qualifying as statutory under 35 U.S.C. 101, in light of *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). Because claim 10 is tied to a particular machine, the communication terminal, and could not be performed as purely mental steps, it is held to be statutory.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claims 15-23, 25, and 26 are allowed.

The following is an examiner's statement of reasons for allowance: The closest prior art of record, Messner (U.S. Patent 6,370,514), discloses an electronic gift certificate circulating method, comprising: (a) receiving a request for usage from a user of the system via a communications terminal (column 7, lines 18-43; column 9, line 66, through column 10, line 20); (b) inquiring the gift certificate database of an existence state of the gift certificate possessed by the user (column 10, lines 21-37); (c) settling the price with the gift certificate and determining whether the settlement is possible (column 10, lines 28-57); (d) processing the settlement on the price information when a settlement is possible (column 10, lines 28-57), (e) updating the settlement information,

and storing the updated information in the gift certificate database (column 10, lines 28-57, especially lines 38-43); and (f) notifying the user of the gift certificate usage information in a message format (column 10, lines 28-57, especially lines 38-43). Messner does not expressly disclose that the usage request is selected by the user from among the gift certificate information stored in the communication terminal, but does disclose delivering messages regarding a gift certificate to a recipient, by email or other means (column 9, lines 51-65). It is well known to store received emails in the communication terminals of recipients, which would result in gift certificate information being stored in the communication terminal.

Messner does not expressly determining the existence state of the gift certificate prior to transferring the gift certificate to a transferee, but Neofytides teaches storing gift certificates or other stored value instruments in a database prior to transferring them to transferees (paragraph 22), which implies determining their existence, since non-existent certificates cannot properly be transferred.

Messner does not expressly disclose that the electronic gift certificate is a multimedia message including barcode data, but Sliwa ("Retailers Mull Pulling Plug on E-Commerce") teaches emailing bar-coded gift certificates (paragraph beginning, "The Reynoldsburg, Ohio-based women's apparel retailer"), implying messages that include barcode data, and multimedia messages are well known as taught, for example, by Aho et al. (U.S. Patent Application Publication 2001/0039589) (paragraph 6).

Messner does not expressly disclose that the electronic gift certificate information stored by the gift certificate database includes at least one of a gifting history of the gift

certificates and a usage history of the gift certificates, but Benston ("Retailers Report Problems Verifying Gift Certificate Cards") teaches maintaining gift certificate histories on a computer, which from context appears to include at least one of a gifting history and a usage history (paragraph beginning, "An advantage of the cards, other than", et subseq.).

However, Messner does not disclose that settling the price with the gift certificate and determining whether the settlement is possible comprises presenting the gift certificate by displaying barcode data on the communication terminal, and neither does any other prior art of record. In particular, Sliwa discloses emailing bar-coded gift certificates to customers, and Kitaura et al. (U.S. Patent Application Publication 2002/0091569) discloses an electronic coupon system wherein coupon barcodes can be displayed using cellular phones (see, e.g., paragraphs 115-118), but this is not quite the same as the recited claim limitation. In Kitaura, coupons are presented, rather than gift certificates, and the presentation does not appear to settle the whole price; and determining the existence state of such a coupon, as in Kitaura, would not involve a gifting history or usage history, since coupons do not have a gifting history or usage history in the same sense as gift certificates.

Furthermore, because claim 15 is a method claim, it has been examined for qualifying as statutory under 35 U.S.C. 101, in light of *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). Because claim 15 is tied to a particular machine,

the communication terminal, and could not be performed as purely mental steps, it is held to be statutory.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Christensen et al. (U.S. Patent 5,710,886) disclose an electric couponing method and apparatus. Kitaura et al. (U.S. Patent Application Publication 2002/0091569) disclose an electronic coupon system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith, can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

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Art Unit: 3625

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Primary Examiner, Art Unit 3625  
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